

REMARKS

Patent Application No.: 09/896,680

Responsive to the Outstanding Office Action Mailed 12/01/2005

Sir:

1.

(A) This is responsive to the Patent Office Action date mailed 12/01/2005 (Dec. 1, 2005) made Final regarding the PREVIOUSLY ALLOWED Patent Application No. 09/896,680 filed 06/29/2001 by Sole Inventor Brad A. Armstrong.

(B) Attached are a Petition and fee payment under 1.136 for an additional period of three months in which to respond to the Office Action.

(C) Attached are a RCE and the fee payment therefore.

Large entity Fees are applied due to licensing of the invention to Sony.

2.

It is noted in the 12/01/2005 "Office Action Summary" that the Action is responsive to Applicant's communication filed 31 October 2005. It is also noted that claims 1-51 and 54-56 are pending and rejected. It is noted the Office Action is made Final. It is noted the drawings filed 29 June 2001 are again accepted.

3.

Regarding the "Detailed Action" starting on page 2 of the 12/01/05 Office Action:

Regarding point "1.": The quote from 35 USC 102 is noted. The Examiner is reminded that Applicant and **two United States Patent Examiners** disagree that Furukawa (5-87760) teaches or suggests the claimed invention.

4.

Regarding point 2, the 35 U.S.C. section 102(b) and 103(a) rejections of claims 1-3, 6-17, 20-24, 30-31, 39, 42, 50, 51 & 54-56 detailed on pages 2-4 of the 12/01/2005 Office Action over Furukawa (5-87760):

Noted is the specific listing of elements believed found by the Examiner in Furukawa and in Applicant's claims.

All of the rejections in the Office Action based on prior art whether 35 USC 102 or 103 are based primarily upon the Furukawa Japanese document No. 5-87760, i.e., Furukawa relied upon by the Examiner to provide elements which must be shown in the prior art by law in order to support a proper rejection. While Furukawa is clearly the foundation of the Examiner's case for rejection under both 35 USC102(b) and 103(a) of all claims 1-52, 54-56, the Examiner does, later in the Office Action, combine Terajima, Japanese document No. 7-302159, with Furukawa to show additional specific elements believed by the

Examiner to be present in Terajima and missing from Furukawa for the obviousness rejections.

5.

(A) WITHDRAWAL OF THE REJECTIONS UNDER 35 U.S.C 102(b) & 103(a) is requested because Furukawa does not teach the claimed invention, please see Furukawa and the Manual of Patent Examining Procedures MPEP 2131, and Furukawa does not suggest the claimed invention with or without its combination with Terajima, please see MPEP 2143.03 for the requirements of a rejection under 35 USC 103(a) and please consider the following.

5(A) THIS IS A FORMAL REQUEST

Applicant has paid a great deal of money to the PTO and is thus, for that reason as well as others, entitled under the Law to a competent examination and subsequent reexaminations of his application. **Therefore**, it is now formally requested that the Examiner get his Supervisor and or the Art Group Director to directly assist him with this examination, because the Examiner is very clearly not understanding what Applicant stated in his last response which addresses patentability of the claims.

5 (B)

Regarding the present rejections: The present claims all basically, with many claims having additional limitations, include: a two hand held game

controller with one or more pressure sensitive buttons on the right hand side or with an individual or discrete pressure button. The "discrete" pressure sensitive button on a game controller is addressed in the "reasons for allowance" by Examiner Paradiso in the 04/23/2002 Patent Office Action. A discrete pressure sensitive button is not described in the Furukawa reference on a game controller. The pressure sensitive buttons of the invention are analog or using analog switches or analog sensors. Functionally, with the invention the right pressure sensor is for receiving variable pressure from the user to cause variable actuation of timing critical aspects of games such as braking a car, accelerating a car, or jumping a character. With the invention, analog pressure button use in the right hand position provides for timing of the start of the character jump as well as how high or far the character jumps, that being determinable by the start of pressing the button as well as or combined with how hard the button is pressed, i.e. the magnitude of the pressure. Using pressure sensor buttons allows the user to feel the varying pressure between his finger or thumb and the button, giving him important feedback. Right hand located and or individual (discrete) analog buttons on two hand held game controllers are novel and not suggested in the prior art.

5(C)

In the 12/01/05 Office Action the Examiner details his opinion and also details what in Furukawa lead to him to drawing that particular opinion regarding the patentability of the current invention. As will be shown, there are very

significant errors in the Examiner's reading and understanding of Furukawa, the errors have clearly lead the Examiner to the entirely improper rejection under 35 USC 102 and 103. All pending claims should be held allowable because the Examiner's misunderstandings of Furukawa are at the heart of the issue of patentability of the present claims. Contrary to the Examiner's current understanding, Furukawa teaches and suggests **only** left hand pressure sensors which are combined together in a multi-directional rocker referred to as a cross key 12 for steering of characters, a significantly different spatial control arrangement utilizing the opposite side of the human brain than is used for timing critical control functions with the present invention. Such is well detailed and made critical in Applicant's "Summary of the Invention" section of the current Application.

The Examiner mistakenly believes Furukawa teaches and suggests right hand pressure sensor buttons, and for the reasons identified by the Examiner in his writings. The evidence of this error forming the foundation of the rejections is as follows:

Firstly, the Examiner states in the first sentence on page 3 of the Office Action:

"Furukawa clearly teaches buttons 19 &20 on the right side of the controller. Since the only switches discussed in the reference are analog switches such as those depicted in figures 2 and 3, Examiner believes these switches to be analog."

The Examiner, as shown by the above quotation, clearly has misunderstood the Furukawa reference as a whole in the following very critical ways:

1) The Examiner states:

“Since the only switches discussed in the reference are analog switches”.

It is clear the Examiner believes only analog switches are discussed in the Furukawa reference, as the Examiner clearly states so in the first sentence of page 3. It is clear because he states so, that the Examiner bases his belief that Furukawa teaches and suggests right hand or discrete pressure sensitive buttons on this misunderstanding that only analog switches are discussed by Furukawa. The Examiner then bases his rejections on this mistaken belief that only analog switches are discussed in the Furukawa reference. **However, it is clearly not the case that only analog switches are discussed in the Furukawa reference.** The Furukawa reference **does** in fact discuss On/Off or digital switches called contact switches, i.e., **non analog** switches on page 3 (English translation of Furukawa) beginning at the paragraph starting with “A conventional rubber contact of this type” with the digital switch discussion continuing through the balance of page 3 and into the top of page 4 of Furukawa.

2) Following “the only switches discussed in the reference are analog switches” portion of the Examiner’s statement, the Examiner then further states:

such as those depicted in figures 2 and 3,

Again, in yet another very clear and significant way, the Examiner's opinion about what the Furukawa reference describes, and thus the very foundation of his rejections, **is completely wrong due to misunderstanding of the Furukawa reference.** The Examiner wrongly states that **figure 3** of Furukawa shows an analog switch like that of figure 2. **However,** contrary to the understanding of the Examiner, **the figure 3 drawing in Furukawa is the On/Off or digital (not analog) contact switch** discussed for almost an entire page of writing on pages 3 and 4 in the English translation of Furukawa. **Clearly the Examiner's understanding of figure 3 is entirely incorrect, as is his understanding of Furukawa as a whole. This misunderstanding is at the heart of his evidence and is why the Examiner believes that Furukawa teaches or suggests pressure sensor buttons on the right hand side of the controller.**

5(D)

Clearly the Examiner's opinion is formed upon several key misunderstandings of Furukawa. These misunderstandings have been utilized to form faulty grounds for rejection over the prior art. The 35 USC 102 and 103 rejections are critically flawed, unsupported and entirely based upon critically flawed understandings of the Furukawa reference. Therefore the rejections **must be withdrawn as improper under 35 U.S.C. 102, 103 and the Manual of Patent Examining Procedures.**

Combining Terajima with Furukawa as in points 3 and 4 of the 12/01/05 Office Action when the Examiner relied upon Furukawa fails to teach or suggest that which the Examiner believes and relies upon, *supra*, renders the combination of the two references **lacking the legally required elements**, teachings and suggestions supporting a proper obviousness rejection. Additionally, the Examiner is not allowed to speculate, but must support each and every contention with specifically identified material pointed to within the prior art, for the statutes are interested in what one of ordinary skill in the art would see in the prior art, **not** what the Examiner believes he sees, particularly when he impermissibly applying hindsight personal opinion.

In *re Dembiczak* (Fed. Cir. 1999) the United States Court of Appeals for the Federal Circuit reversed the PTO Examiner and the Patent Office Board of Appeals in a patent application rejected on obviousness grounds stating:

*"...Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." "For it is this phrase that guards against entry into the tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section." "Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." "Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a **showing** of the teaching or motivation to combine prior art references." "the Board must **identify** specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them" "examiner can satisfy burden of obviousness in light of combination only by showing some objective teaching leading to the combination" "strict observance" of factual predicates to obviousness conclusion required".*

*"Combining prior art references without **evidence** of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight."*
 (The above underlining and bolding by Applicant for emphasis)

In the present Office Action of 12/01/2005, the Examiner has not pointed to any "**objective** teaching leading to the combination" of references, but instead has apparently used the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, an improper yet common basis for claim rejection due to "*the insidious effect of a hindsight syndrome*".

In RE MARY E. ZURKO decided Aug, 2, 2001, the United States Court of Appeals for the Federal Circuit again reversed the PTO Examiner and the Patent Office Board of Appeals in a patent application rejected on obviousness grounds stating:

*"We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, **the Board must point to some concrete evidence in the record in support of these findings.**"*

In the present case, the Examiner has not pointed to any "**concrete evidence**" in the record supporting the combination of the relied upon references.

The PTO wishes to follow the guidance of the United States Court of Appeals for the Federal Circuit in deciding the patentability of claims.

Please see the following cases from the Board of Patent Appeals and Interferences readily available on the PTO web site where U.S. Patent Examiners were reversed on rejections based on obviousness similar to the present rejection wherein the suggestion or motivation to combine references lacked **substantial or concrete evidence** pointed to by the Examiner.

Appeal No. 2004-1223 Please see pages 9-11 at least.

Appeal No. 2003-2018 Please see pages 4, 6-7 at least.

Appeal No. 2001-0326 Please see pages 6-8 at least.

Appeal No. 1999-2115 Please see pages 4, 7 at least.

Appeal No. 2001-1008 Please see pages 4-6 at least.

As clearly shown in the opinions of Board of Patent Appeals the PTO wishes to follow the guidance of the United States Court of Appeals for the Federal Circuit in deciding the patentability of claims. Additionally shown is that rejections based on obviousness must be supported by **substantial or concrete evidence** pointed to by the Examiner and made of record as **objective evidence**. Additionally shown is that the burden of establishing prima facie obviousness is on the Examiner and does not shift away, such as to Applicant, until a proper prima facie case has been made based on **substantial or concrete evidence**. Further shown herein is that **prima facie obviousness cannot be established without "all" elements of a claim being taught or suggested in the relied upon references, this requirement not met in any of the current claims as shown supra.**

No prima facie case for obviousness has been made against any of the pending claims.

Therefore allowance of the claims 1-51, 54-56 over the prior art is respectfully requested and would be the correct and fair finding. Thank you.

6. Briefly addressing the Examiner's "Response to Arguments" comments located on page 6-7 of the Office Action:

Applicant has noted the Examiner's points 5-7.

Regarding point 8: One dictionary, as the Examiner states, defines "discrete" as separate entity, individually distinct. 19 and 20 might be discrete buttons in Furukawa, but they are stated to be "trigger keys" and not the "steering control" buttons of the cross key 12 which are pressure sensitive yet inherently tied together in the rocker or cross key fashion. Rocker switches, buttons or keys being inherently tied together are not discrete buttons, sensors or the like.

The laws pertaining to claim word differentiation in interpreting claim meaning under the law and applied every day in the Courts is believed to be a reasonable theory when interpreting the meaning to different words in a specification, therefore when buttons 19 and 20 in Furukawa are only referred to as "trigger keys" and never once as "steering control" buttons as with the cross key 12, and

the pressing surfaces or sensors keys of cross key 12 are never once referred to as "trigger keys" then if one were forced to speculate, one would reasonably conclude the keys of buttons 19 & 20 are different in structure and function from cross key 12 based on the accepted theory of patent claim word differentiation.

7. Regarding what the Examiner is stating in his point 9 on pages 6 and 7: The "misunderstanding" is on the Examiner's part, for example, he states Fig. 3 in Furukawa is an analog switch, which it is clearly not. And further wherein the Examiner clearly states he is basing his rejection on Furukawa because Furukawa does not discuss any switches other than "analog" which as shown herein above is entirely wrong. Additionally, Furukawa does not state anywhere that the contact switches, that the Examiner states are never discussed in the first place (see grounds for rejection) are not used in the controller. Furukawa must be viewed as a whole.

Furthermore, when the Examiner states in his "comments" page 6 point 9 of the Office Action that Furukawa does indeed discuss digital switches, and this is **directly contrary to the Examiner's statement** detailing what is and what is not discussed in Furukawa in the Rejection portion of the Office Action and pages 2-5 of the 12/01/05 Office Action, this clear and extremely important contradiction by the Examiner is further evidence that the Examiner is not properly supporting grounds for rejection. The grounds for rejection **must** be withdrawn as they are

completely inadequate. The claims are allowable as previously properly determined by two U.S. Patent Examiners.

8. Regarding the Examiner's point 10 allegation that Applicant stated Sony has been charged with applying patent laws of the United States, Applicant never said that, but the U.S. Supreme Court has stated Secondary considerations when present, must be considered, please see **Graham v. John Deere** , 383 U.S. 1, 148 USPQ 459 (1966), and MPEP at 2141 III for issues such as **commercial success and licensing activities**. The Examiner believes that the fact that Sony paid many millions of dollars for a license to the current invention has no bearing on whether the invention may in fact be new and patentable. That belief by the Examiner is not based in fact, and does not recognize that the U.S. Courts overseeing the U.S. Patent Office have repeatedly stated in essence that sometimes secondary considerations are a better indicator of patentability than the prior art. Commercial success and licensing activities is not needed to find all of the present claims allowable in any case.

(9) Applicant can prove each statement made herein, and has made every effort to keep this response brief. If the Examiner wishes greater details, copies of Appeals Board Rulings, Court cases and the like, then please say so and such

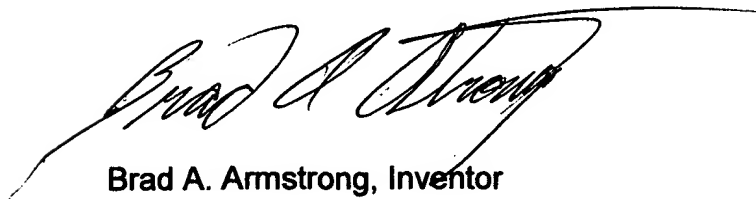
will be provided, but otherwise Applicant is trying to keep the amount of writing and paperwork to a minimum as earlier requested by the Examiner.

(10) Applicant believes the Patent Office does not have any valid grounds to further delay the advancement of this Application once again toward Patent Issue. Please find the Application once again in condition for allowance. Thank you.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true: and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Thank you for your careful consideration of this very important matter.

Very Respectfully,



Brad A. Armstrong, Inventor

6-1-06

Date: